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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,046	06/24/2003	James H. Wright	WRIGP001US	1045
27949 7590 06/22/2009 LAW OFFICE OF JAY R. YABLON 910 NORTHUMBERLAND DRIVE SCHENECTADY, NY 12309-2814				
EXAMINER				
JOYNER, KEVIN				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
06/22/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/604,046

**Applicant(s)**

WRIGHT, JAMES H.

**Examiner**

KEVIN C. JOYNER

**Art Unit**

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 and 12-60 is/are pending in the application.
- 4a) Of the above claim(s) 17-20, 22 and 30-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-16, 21 and 23-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**FINAL ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-10, 12-16, 21, 23-25, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lillelund et al. (U.S. Patent No. 4,923,085) in view of Allen et al. (U.S. Patent No. 5,515,995).

Lillelund discloses an apparatus that is capable of being utilized as an anti-splash, anti-spill fluid-holding apparatus (referenced as a container), comprising:

an inner side surface comprising an inner mid section diameter thereof continuing inwardly to an inner upper section diameter thereof which is smaller than said inner mid section diameter, from more than two side cross-sections (Figures 9 and 10);

an outer side surface further comprising an outer diameter thereof which, between said outer lower section diameter and an outer upper section diameter thereof, substantially never increases when moving from any lower circumference thereof to any higher circumference thereof, from more than two side cross-sections (Figure 1);

an open top circumscribed by said inner upper section diameter (Figure 2);

an inward angle comprising a less than 90 degree angle tangential to any point along said inner side surface from said inner mid section diameter to said inner upper section diameter, from more than two side cross-sections, wherein said inward angle is greater than zero degrees at said open top (column 5, lines 5-10; Figures 9 and 10);

a base circumscribed by said outer lower section diameter; and

said inner side surface, said outer side surface, said inward angle, said open top which is smaller than said inner mid section diameter, and said base circumscribed by said outer lower section diameter which is larger than said outer mid section diameter, all comprising a single, unitary article of fabrication (Figures 1 and 2), wherein the container of Lillelund is further provided with a lid to seal said container. More specifically, as shown in Figures 9 and 10, the upper inner section of Lillelund angles inwardly in order to provide friction between the lid and said upper inner portion (column 5, lines 5-10).

Lillelund does not appear to disclose the type of material that the container is made from. However, it is extremely well known in the art of containers with lids to comprise the containers from a rigid material with the rigidity substantially similar to that of a shot glass. Allen discloses an apparatus that is capable of being utilized as an anti-splash fluid holding container comprising a lid (Figure 1) to seal said container, wherein the container further comprises:

An inner side surface comprising an inner mid section diameter thereof and an inner upper section diameter thereof;

An outer side surface comprising an outer mid section diameter thereof continuing to an outer lower section diameter thereof which is larger than said outer mid section diameter, from more than two side cross-sections;

Said outer side surface further comprising an outer diameter thereof which between said outer lower section diameter and an outer upper section diameter thereof, substantially never increases when moving from any lower circumference thereof to any higher circumference thereof, from more than two side cross-sections; and

An open top circumscribed by said inner upper section diameter as shown in Figure 3. The reference continues to disclose that the container is made from a plastic material, which is a material with the rigidity substantially similar to that of a shot glass (column 8, lines 1-9), as it is commonly well known in the art comprise containers from a material that is substantially similar to that of a shot glass in order to provide a stable support material. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to comprise the container of Lillelund from a material with the rigidity substantially similar to that of a shot glass such as plastic, as it is extremely common and commercially well known in the art in order to provide a stable support material as exemplified by Allen.

Lillelund does not appear to disclose that the container comprises an outer side surface comprising an outer mid section diameter thereof continuing to an outer lower section diameter thereof which is larger than said outer mid section diameter, from more than two side cross-sections (i.e. a supportive base). However, it is also extremely well known in the art to provide such an outer lower section diameter in order to prevent

spilling contents in the container. As disclosed above, Allen also discloses this conventional knowledge as shown in Figure 3, wherein Allen discloses that the wide base is provided to prevent spilling any contents in the container (column 1, lines 5-10). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the container of Lillelund to include an outer side surface comprising an outer mid section diameter thereof continuing to an outer lower section diameter thereof which is larger than said outer mid section diameter, from more than two side cross-sections in order to prevent spilling contents in the container as exemplified by Allen.

Regarding claim 7, the reference of Lillelund in view of Allen is fully capable of omitting any anti-splash element comprising an inward angle greater than or equal to 90 degrees tangentially at any point between said inner mid section diameter and said inner upper section diameter. Concerning claim 8 the reference of Lillelund also discloses that said inward angle continuously increases at all points along said inner side surface from said inner mid section diameter to said inner upper section diameter as shown in Figure 3.

Claims 2-6 further requires that the inward angle comprises no more than approximately 15 degree angle tangential to any point from said inner mid section diameter to said inner upper section diameter. It would have been well within the purview of one of ordinary skill in the art to optimize the angle tangential to any point from said inner mid section diameter to said inner upper section diameter to no more

than 15 degrees in order to maximize the sealing properties of the apparatus of Lillelund. Only the expected results would be attained.

Claims 9 and 10 further requires that the inner section ratio be approximately 1 to 0.875 between said inner mid section diameter and said inner upper section diameter. It would have been well within the purview of one of ordinary skill in the art to optimize the ratio between the inner mid section diameter and the inner upper section diameter in order to optimize the ratio of the apparatus in accordance with a specific operation. Only the expected results would be attained.

Claims 12 and 13 further requires that the fluid holding volume is approximately 37.5 cubic centimeters. It would have been well within the purview of one of ordinary skill in the art to optimize the fluid holding volume in order to maximize the appropriate amount of fluid needed for the usage of the apparatus. Only the expected results would be attained.

Claims 14-16 further requires that the inner side surface height be approximately 3 centimeters and the inner mid section diameter by approximately 4 centimeters. It would have been well within the purview of one of ordinary skill in the art to optimize inner surface height and inner mid section diameter in order optimize the size of the apparatus in accordance with a specific operation. Only the expected results would be attained.

Claim 21 further requires that the outward angle comprise an approximately 30 degree angle tangential to at least one point from said outer mid section diameter to said outer lower section diameter. It would have been well within the purview of one of

ordinary skill in the art to optimize the angle between the outer mid section diameter and the outer lower section diameter in order to maximize the stability of the apparatus.

Only the expected results would be attained.

Claims 23 and 24 further requires that the outer mid section diameter and the outer lower section diameter be at a ratio of approximately 1 to 1.33. It would have been well within the purview of one of ordinary skill in the art to optimize the ratio between the outer mid section diameter and the outer lower section diameter in order to maximize the stability of the apparatus. Only the expected results would be attained.

Concerning claim 27, Lillelund in view of Allen discloses that the inner side surface, the outer side surface, said points along said inner side surface forming said inward angle, and said base comprises a single unitary article of fabrication as described above concerning claim 1. Lillelund in view of Allen do not appear to disclose the fluid holding volume or the angle between the inner mid section diameter to the inner upper section diameter. However, it would have been well within the purview of one of ordinary skill in the art to optimize fluid holding volume and the angle between the inner mid section diameter to the inner upper section diameter in order to maximize the sealing properties and the appropriate amount of fluid needed for the usage of the apparatus in accordance with a specific operation. Only the expected results would be attained. Regarding claims 25 and 28, the apparatus of Lillelund in view of Allen is fully capable of being in a sterile state suitable for utilization in surgical procedures.

3. Claims 26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lillelund et al. (U.S. Patent No. 4,923,085) in view of Allen et al. (U.S. Patent No.



5,515,995) as applied to claim 1 and 28 above, and further in view of Mann (U.S. Publication No. 2004/0031721).

Lillelund in view of Allen is relied upon as set forth above. Lillelund in view of Allen does not appear to disclose that the apparatus is in combination with a surgical kit comprising the apparatus and at least one other item of surgical equipment. Mann discloses a surgical kit comprising an item of surgical equipment (paragraphs 12 and 13), and containers (110 & 130) that are capable of being utilized as an anti-spill apparatus. More specifically, the containers provide adequate support for preventing various specimens (paragraphs 25-26) inside said containers from spilling by their base portions. Therefore, they are anti-spill containers. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the anti-spill apparatus of Lillelund in view of Allen in surgical kits comprising surgical equipment; as such apparatus are known to be utilized in surgical kits as exemplified by Mann.

### ***Response to Arguments***

4. Applicant's arguments filed February 5, 2009 have been fully considered but they are not persuasive.

*Applicant's principle arguments are:*

*a) Allen is clearly used for drinking beverages wherein the container does not contain Applicant's gradually narrowing region toward the top, which would make it clumsy to drink from such a container. In fact, Allen actually teaches widening the top region as shown in Figure 3, wherein the second end 27 of inner wall 25 actually grows*

*wider when moving upwards along region 14. As such, Allen directly teaches away from Applicant's independent claim 1 as set forth in the claims of this response, and from the narrowing top of Lillelund. Primarily, Lillelund is for a lid for a container, such that the "container mouth requires no unique structural configuration to accommodate the lid..." (column 2, lines 9-12). The only portion of Lillelund which stimulates even the remotest comparison to any aspect of Applicant's invention is the statement in column 5, lines 5-10 that "the mating surface of the sealing flange 32 and the container surface 44 inward of the mouth edge 24 may have frictionally engaging projections or lip-like portions to enhance the seal." This is grossly insufficient to support the cited combination with Allen which, as shown above, itself teaches away from any such combination.*

*Lillelund, first of all, does not in any way discuss avoiding spilling or splashing or tipping, which is a fundamental motivation of Applicant's invention. Thus, there is absolutely no teaching or suggestion or motivation to combine Lillelund with Allen in the manner suggested by examiner, "in order to prevent spilling contents in the container." Furthermore, if Lillelund was motivated to avoid spilling or splashing or tipping, and to do so in the manner invented by Applicant rather than in the well-known manner of providing a lid to seal a container, then any person of ordinary skill who is so-motivated would never show the container 20 illustrated as cylindrical and elongate in Figures 1-10. Such a cylindrical and vertically elongate container configuration is well known to be the least stable and most prone to spilling of virtually any container configuration imaginable. There is nothing anywhere in Lillelund which suggests that one moment of*

*attention has been devoted to the issue of configuring a container to prevent spilling and splashing and tipping, and so there is simply nothing in Lillelund that in any way can be said to motivate a combination with Allen.*

It is noted that Allen does not teach away from the narrowing upper region as set forth in the Applicant's response. A mere showing that the reference does not narrow, or may even grow wider (which is not the opinion of the Examiner) is not sufficient evidence that Allen teaches away from these limitations.

Furthermore, simply put Allen discloses a container for drinking beverages and a lid (16) with said container. As is extremely well known in the art, the lid is provided to prevent the contents in the container from spilling. Lillelund discloses a container and a lid that seals to the container, wherein lids are provided to prevent spilling the contents located in the container. It is commonly known that sealing the lid deters the lid from falling off the container. Lillelund explicitly discloses in Figure 10, "an inner side surface comprising an inner mid section diameter thereof continuing inwardly to an inner upper section diameter thereof which is smaller than said inner mid section diameter," as well as "an inward angle . . . wherein said inward angle is greater than zero degrees at said open top" in order to enhance the sealing relationship between the container and the lid (column 5, lines 5-10). More specifically, enhancing the sealing relationship deters the lid from falling off the container, which prevents the contents in the container from spilling. As such, it would have been obvious to one of ordinary skill to provide the container of Allen with an inward angle at the top to engage with the lid of Allen in order to deter the lid from falling off the container and prevent the contents in the container

from spilling. Therefore, the combination is proper and fully meets the limitations of the claim.

Regarding the statement that Lillelund does not disclose an anti-spilling apparatus; a container provided with a lid is an apparatus that prevents spilling, wherein each reference is directed to an apparatus for containing a material with a lid that prevents spilling of the material. As such, the references are properly combinable.

*b) There is no teaching, suggestion or motivation to combine the Lillelund and Allen references to arrive at Applicant's claimed invention, for the reasons stated above. As stated before, the motivating factors behind the design of a drinking device—which have previously been discussed in the record for this case - are simply not the same as those behind the design of a device for holding surgical fluids such as that which Applicant has invented.*

As set forth above, motivation is provided by Lillelund to comprise said inward angle at the top portion of the container in order to enhance the sealing relationship between the container and the lid (column 5, lines 5-10). In response to applicant's argument that the motivating factors behind the design of a drinking device are not the same as the factors behind the design of a device for holding surgical fluids, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

*c) Applicant's invention must be taken "as a whole," and cannot be subjected to "impermissible hindsight." Loosely speaking, the Applicant's invention combines a top half [the narrowing upper region] and a bottom half [gradual widening of the base] into a unitary device. Respectfully, despite numerous Office Actions, and despite the literally millions of fluid containers, examiner has repeatedly failed to find a single example of a drinking device or any other fluid holding device which combines all of the claimed elements of Applicant's invention. This fact alone provides virtually irrefutable evidence that Applicant's invention really is NOT obvious as examiner asserted. To continue with the analogy, there are many types of fish (bottom half of Applicant's invention) in the world and many types of female human beings (top half of Applicant's invention) in the world. Applicant has invented a "mermaid" (top and bottom halves all in one) and the examiner keeps finding references for fish and female human beings in an effort to assert that it "would have been obvious" for someone to invent a mermaid. Yet despite countless opportunities over time for a mermaid to have evolved, such has never happened, and this points strongly away from the asserted obviousness of the combination. Unless examiner can produce prior art directly anticipating Applicant's invention under 35 U.S.C. 102, rather than produce an endless progression of 103 combination of humans and fish without finding a mermaid, the time has arrived following action after action to recognize that the apparatus which Applicant has invented in fact does not exist and has not previously been invented despite countless opportunities for it to have been invented.*

It appears as though the Applicant may need to be reminded of the statutes and guidelines concerning 35 U.S.C 103(a) rejections wherein a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made. Furthermore, the references of Allen and Lillelund are both directed to an apparatus comprising a container and a lid for sealing the container and preventing the contents from spilling from said container. Lillelund discloses that the upper portion of the container can progress at an inward angle in order to enhance the sealing engagement between the lid and the container. As such, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the upper portion of the container of Allen to progress at an inward angle in order to enhance the sealing engagement between said lid and container and further prevent spilling from said container as exemplified by Lillelund.

*d) The containers in Mann cited to reject claims 26 and 29, to the extent that they prevent spilling, do so because they are closed containers just like millions of other closed containers that exist in the world. Mann does not disclose, suggest or motivate any features of these containers which would deter splashes and spills when these containers are opened, i.e., that deter spillage when they have an open top.*

Mann is merely relied upon to provide evidence that an anti-spill apparatus is utilized in a surgical kit, wherein Allen in view of Lillelund discloses the specific features of the apparatus. Said apparatus (110 and/or 130) of Mann is fully capable of deterring spilling of contents in the containers. Therefore, the limitations of the claims are met. The Applicant is reminded that The Manual of Patent Examining Procedures specifically states that, "while the features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function" as well as, "a claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim." (MPEP 2114 [R-1]). As such, the containers of Mann meet the limitations of an anti-spill, anti-splash apparatus.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN C. JOYNER whose telephone number is (571)272-2709. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KCJ

/Sean E Conley/  
Primary Examiner, Art Unit 1797